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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/597,711

**Applicant(s)**

GUTTORMSEN, OVE KORNELIUS

**Examiner**

NAHID AMIRI

**Art Unit**

3679

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,10,11,13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 12 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/17/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

In view of Applicant's Amendment received 16 March 2009, amendments to the claims have been entered. Claim 9 is canceled. Claims 1-8 and 10-14 are pending.

Claims 4, 5, 10, 11, 13, and 14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 31 December 2008.

However, with respect to Applicant's remark that restriction is improper because some of claims were allowable and also the amendment filed clarified the claims in response to the examiners previous rejection for indefinites. This is not persuasive.

Examiner points out that while some claims may have been indicated to be allowable, claim 1 was not one of them. Further, the past indication of allowability of claims 3-5, 7 and 8 was premature in that, as indicated below, claim 3 is rejected. Further, claims 4 and 5 are not drawn to the elected species.

Further, in view of Applicant's remarks on page 2 of the response, it is now clear and evidence that the instant application involves numerous patentably distinct species and there is a serious burden on the examiner to have to continue to examine each species in the same application when no corresponding patentable technical features are present in the independent claim(s). In as much as a restriction requirement may be made whenever appropriate at any time before final (see MPEP 811), a provisional election requirement as set forth below is now necessary.

Finally, it should be noted that should there be an independent claim that becomes allowable all properly dependent claims will be rejoined.

However, Applicant argues that the some identified groups such groups 2, 6-7 and 9 had no identified claims, therefore, they should not be included in the grouping. This is persuasive. Therefore, the Grouping are as follow:

This application contains claims directed to the following patentably distinct species of the claimed invention: Group 1, Figs. 1a-1e; Group 2, Figs. 3a-3e; Group 3, Fig. 5; Group 4, Figs. 4a-4e; and Group 5, Figs. 8a-8e.

**Claims 1, 2, 3, 6, 7, 8 and 12** drawn to Group 1, the claims 2 and 3 drawn to a device with first abutment portions having two lugs and **claim 6**, a second abutment portion of a device having a "a deflectable retaining spring" and **claim 7**, the device having release bar. It is considered that the two lugs, the deflectable retaining spring and release bar comprise a second "special technical feature".

**Claims 1, 4 and 5**, drawn to Group 2, drawn to a second abutment portion of a device having a "projecting stop". It is considered that the projecting stop comprises a third "special technical feature".

**Claims 10, 11, 13 and 14**, drawn to Group 3, drawn to each of the rail of the device having a "hook". It is considered that the hook comprises a fourth "special technical feature".

### ***Drawings***

The drawings were received on 16 March 2009. These drawings are approved.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 6-8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 12-14, defines that the edge-to-edge abutment prevents "the maximum" penetration. However, the "maximum penetration" is defined and limited by the edge-to-edge abutment. Therefore, it is unclear what "maximum" penetration the claim is referring to since

the edge-to-edge abutment defines the maximum penetration but does not prevent the defined maximum from being attained.

Claim 3, there is no antecedent basis for "the wedge-shaped engaging part", lines 3-4.

Claim 12, line 2, it is unclear what constitutes "a respective profiled attachment fitting". Examiner examines the claim as best understood.

### ***Claim Objections***

Claims 2, 3, 6, 7, 8 and 12 are objected to because of the following informalities:

Claims 2, 3, 6, 7 and 8, line 1 "A device as disclosed in" should be changed to --The device according to--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

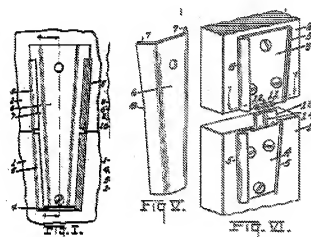
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 1,182,610 Wiesman.**

With respect to claim 1, Wiesman discloses a device (Figs. I, V, VI, VIII) for connecting structural elements (1, 2), the device consisting of a male component (M) and a female component (constituted by a wedge 6) having at least over a part of their length wedge-shaped engaging parts having an almost dovetail-shaped, gradually decreasing cross-section, and wherein the male component (M) and the female component (6) are mountable on a face or edge

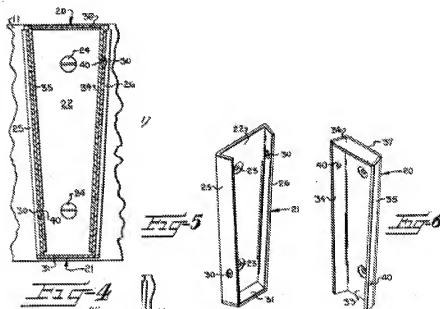
of the structural elements (1, 2) in order, on movement of the structural elements (1, 2) relative to each other, to cause the male and female components (M, 6) to engage wedgingly, characterised in at least a first abutment portion (constituted by a flange 5) is formed on the male component (M0 and at least second abutment portion (constituted by a diverging flange 7) on the female component (6) for edge-to-edge abutment against each other when the male component (M) and the female component (6) are engaged a predetermined amount, the edge-to-edge abutment being made to prevent the male component (M) from penetrating wedgingly to the maximum into the female component (6), thereby avoiding mutual deformation of the male and female components (M, 6) or material strain thereof on penetration.



With respect to claim 12, it should be noted that the claims are drawn solely to a device subcombination that includes recitations of intended use for connecting to the structural members. Patentability determination is based on the device recited and not how the device is intended to be used. Thus, it is structure of the device, alone, that is considered. Wiesman discloses (Fig. VI) that the male and female components (M, 6) are attached to a respective profiled attachment fitting (constituted by screws 19) which is securable at least one end portion of a respective structural member.

**Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 2,793,407 Johnston.**

With respect to claim 1, Johnston discloses a device (Figs. 4-6) for connecting structural elements (10, 11), the device consisting of a male component (20) and a female component (21) having at least over a part of their length wedge-shaped engaging parts having an almost dovetail-shaped, gradually decreasing cross-section, and wherein the male component (20) and the female component (21) are mountable on a face or edge of the structural elements (10, 11) in order, on movement of the structural elements (10, 11) relative to each other, to cause the male and female components (20, 21) to engage wedgingly, characterised in at least a first abutment portion (constituted by a flange 25) is formed on the male component (20) and at least second abutment portion (constituted by a flange 34) on the female component (21) for edge-to-edge abutment against each other when the male component (20) and the female component (21) are engaged a predetermined amount, the edge-to-edge abutment being made to prevent the male component (20) from penetrating wedgingly to the maximum into the female component (21), thereby avoiding mutual deformation of the male and female components (20, 21) or material strain thereof on penetration.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston.**

With respect to claim 2, Johnston discloses (Figs. 4-6) that the second abutment portion (34) has two lugs (constituted by knobs 40) and said first abutment portion (25) includes corresponding abutment edge portions, said lugs (40) being arranged to abut against and be supported by the corresponding abutment edge portions on the wedge said male component (20). Johnston fails to disclose that the two lugs positioned on the first abutment portion of the female member. It is well known in the art to provide the lugs at either the first or second abutment portions for the reasons well known in the art. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the first abutment portion of Johnston instead of the second abutment portion with two lugs, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

With respect to claim 3, Johnston discloses (Figs. 4-6) that the second abutment portion (34) has two lugs (constituted by knobs 40) that extend out to the side from a portion arranged in continuation of one of the wedge-shaped engaging parts, and that the female component (20) said second abutment portion (25) similarly has a portion an abutment surface arranged in continuation of its wedge-shaped engaging part in order to abut against and support said lugs (40). It is well known in the art to provide the lugs at either the first or second abutment portions for the reasons well known in the art. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the first abutment portion of Johnston



instead of the second abutment portion with two logs, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

*Allowable Subject Matter*

**Claims 6-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.**

- The prior art does not disclose that “a deflecting retaining spring” of the first abutment portion recited in **claim 6**, lines 2-3.
- The prior art does not provide any teaching, suggestion or motivation (TSM) to modify the prior art as such.
- The deflecting retaining spring produces critical unexpected results (see applicant’s specification page 4, lines 21-24) such that the limitation is not mere common sense or mere design choice.
- There is no cogent reasoning that is unequivocally independent of hindsight that would have led one of ordinary skill in the art at the time the invention was made to modify the prior art to obtain the applicant’s invention.
- The prior art does not disclose that “the inhibiting device is a retaining spring” as recited in **claim 7**, line 2.
- The prior art does not provide any teaching, suggestion or motivation (TSM) to modify the prior art as such.
- The retaining spring produces critical unexpected results (see applicant’s specification page 4, lines 13-17) such that the limitation is not mere common sense or mere design choice.

- There is no cogent reasoning that is unequivocally independent of hindsight that would have led one of ordinary skill in the art at the time the invention was made to modify the prior art to obtain the applicant's invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action by having new interpretation of Weisman, e.g., claim 1, lines 8-10, the limitation of "at least a first abutment portion is formed on said male component and at least second abutment portion on said female component for edge-to-edge abutment against each other when the male component and the female component are engaged a predetermined amount" was not claimed in original claimed invention. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nahid Amiri whose telephone number is (571) 272-8113. The

examiner can normally be reached on Monday through Thursday from 8:00-6:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nahid Amiri  
Examiner  
Art Unit 3679  
May 11, 2009

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679